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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------------|------------------------|
| 09/345,820 | 06/30/1999 | LYNN Y. SHIMADA | 9051.37 | 1703 |
| 21999 7590 12/28/2007 KIRTON AND MCCONKIE 60 EAST SOUTH TEMPLE, SUITE 1800 SALT LAKE CITY, UT 84111 | | | EXAMINER COLBERT, ELLA | |
| | | | ART UNIT 3694 | PAPER NUMBER |
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

09/345,820

Applicant(s)

SHIMADA, LYNN Y.

Examiner

Ella Colbert

Art Unit

3694

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 21 September 2007.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 10-14 and 17-21 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 10-14 and 17-21 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

1. Claims 10-14 and 17-21 are pending. Claims 10, 12, 13, and 18 have been amended in the response filed 9/21/07 entered as Response After Non-Final Action (Response After Informal or Non-Responsive Amendment).
2. The objections to the specification have been overcome by Applicant's amendment to the specification in the response filed 6/15/07 and are hereby withdrawn.
3. The claim objections to claims 10, 12, 13, and 18 have been overcome by Applicant's amendments in the response filed 6/15/07 and are hereby withdrawn.
4. The 35 USC 112, second paragraph and 35 USC 101 rejections in the action of 12/07/06 are hereby withdrawn in view of Applicant's convincing arguments.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

Claims 10-14 and 17-21 are rejected under 35 U.S.C. 102 (b) as being anticipated by (US 5,465,206) Hilt et al, hereafter Hilt.

Claim 10. Hilt discloses, A method for electronically initiating payment of an amount owed to a vendor from a customer computer system regardless of whether the vendor utilizes an electronic payment technology, the method comprising:
generating and transmitting payment print data using any electronic accounting application at the customer computer system for payment of the amount owed to the

vendor, regardless of whether the vendor utilizes electronic payment technology (col. 4, lines 31-41); receiving the transmitted payment print data at a print data reader of the customer computer system, wherein the print data reader includes a check printing module and an electronic payment processing module (col. 4, line 49-col. 5, line 11); preprocessing the transmitted payment print data at the print data reader and determining at the print data reader that effectuating the payment to the vendor includes using an electronic payment file, wherein the preprocessing includes searching for data patterns in the transmitted payment print data (col. 5, line 60-col. 6, line 31); and effectuating the payment by performing the steps of: using the transmitted payment print data to selectively generate the electronic payment file at the electronic payment processing module (col. 7, lines 34-62); transmitting the electronic payment file from the electronic payment processing module of the customer computer system to a third-party electronic payment processing center for effectuating the payment of the amount owed to the vendor (col. 7, line 63-col. 8, line 12); and remitting, via the third-party electronic payment processing center, the amount to the vendor electronically where the vendor is capable of receiving electronic payment, and by physical delivery where the vendor is incapable of receiving electronic payment (col. 7, lines 34-62 and col. 8, line 64-col. 9, line 8).

Claim 11. Hilt discloses, A method as recited in claim 10, wherein if the vendor is incapable of receiving electronic payment, the step for remitting, via the third-party electronic payment processing center, the amount to the vendor further comprises a step for printing, at the third-party electronic payment processing center, a negotiable

instrument in the amount owed to the vendor (col.3, line 52-col. 4, line 6 (amount due, check (negotiable instrument) third party (customer's bank))).

Claim 12. Hilt discloses, A method as recited in claim 10, wherein if the vendor is capable of receiving electronic payment, the step for remitting, via the third-party electronic payment processing center, the amount to the vendor further comprises: generating an automated clearing house (ACH) file at the third-party electronic payment processing center from the electronic payment file; and using the ACH file to effectuate the payment of the amount owed to the vendor (col. 8, line 59-col. 9, line 53).

Claim 13. Hilt discloses, A method as recited in claim 12, further comprising: providing a financial account number of a financial institution that corresponds to the vendor for receiving the payment, wherein the financial institution is coupled to the third-party electronic payment processing center (col. 20, lines 36-67); and receiving the ACH file at the financial institution from the third-party electronic payment processing center (col. 8, line 64-col. 9, line 8 and fig. 3).

Claim 14. Hilt discloses, A method as recited in claim 10, wherein the electronic payment file comprises at least one of the group consisting of remittance data, an invoice number, an invoice date, an invoice description, an invoice amount, a check date, a check number, a check amount, a payee name, and a payee address (col. 6, line 32-col. 7, line 62 and line 52-col. 8, line 8, and fig. 2).

Claim 17. Hilt discloses, A method as recited in claim 10, wherein the electronic payment file is in an ASCII text data format (col. 5, line 60-col. 6, line 16 –machine readable format).

Claim 18. Hilt discloses, A method for using an electronic payment processing module coupled to any local electronic accounting application to effectuate payment of an invoice received from a vendor, regardless of whether the vendor or a financial institution of the vendor employs electronic data exchange for payment processing, the method comprising: providing a customer computer system having any electronic accounting application and the electronic payment processing module (col. 4, lines 31-41); generating and transmitting payment print data using the electronic accounting application at the customer computer system for payment of the invoice received from the vendor, regardless of whether the vendor utilizes electronic payment technology (col. 4, line 49-col. 5, line 11); automatically receiving, at the electronic payment processing module, the transmitted payment print data from the electronic accounting application, wherein the electronic payment processing module is a print data reader and includes a check printing module and an electronic payment processing module (col. 4, line 31-col. 5, line 59); preprocessing the transmitted payment print data at the electronic payment processing module and automatically determining at the electronic payment processing module that effectuating the payment of the invoice to the vendor includes using an electronic payment file, wherein the preprocessing includes searching for data patterns in the transmitted payment print data (col. 5, line 60 -col. 6, line 31); and effectuating the payment by performing steps of: using the electronic print data to selectively generate an electronic payment file at the electronic payment processing module (col. 7, line 34-62); transmitting the electronic payment file to a third-party electronic payment processing system to effectuate the payment of the amount owed by

the customer to the vendor by one of (col. 7, line 63-col. 8, line 12):using an electronic payment technology to effectuate the payment when electronic payment exchange is utilized by at least one of (i) the vendor and (ii) the financial institution of the vendor (col. 4, line 49-col. 5, line 59); and generating and providing a printed negotiable instrument on behalf of the user to effectuate the payment when electronic payment exchange is not utilized (col. 6, line 32-col. 7, line 14).

Claim 19. Hilt discloses, A method as recited in claim 18, wherein the step for using an electronic payment technology to effectuate the payment when the electronic payment exchange is utilized by at least one of (i) the vendor and (ii) a financial institution of the vendor further comprises a step for generating an ACH file to automatically effectuate the payment (col. 5, line 60-col. 6, line 32-col. 7, line 14).

Claim 20. Hilt discloses, A method as recited in claim 18, wherein the electronic payment file comprises at least one of the group consisting of remittance data, an invoice number, an invoice date, an invoice description, an invoice amount, a check date, a check number, a check amount, a payee name, and a payee address (col. 6, line 32-col. 7, line 62 and line 52-col. 8, line 8, and fig. 2).

Claim 21. A method as recited in claim 18, wherein the electronic payment file is in an ASCII text data format (col. 5, line 60-col. 6, line 16 –machine readable format).

Inquiries

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ella Colbert whose telephone number is 571-272-6741.

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The examiner can normally be reached on Monday, Wednesday, and Thursday,
5:30AM-3:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Trammell can be reached on 571-272-6712. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

December 26, 2007


JELLA COLBERT
PRIMARY EXAMINER